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REMARKS**Drawings**

Drawings filed June 28, 2002 stand objected to by the Examiner. Apparently at least one of the drawings, Figure 2, was informal as filed. Applicants respectfully note, however, that the drawings for the present application as shown in the Patent Application Information Retrieval system (PAIR) are correct, formal drawings. In addition, the drawings published in the present case, in U.S. Patent Application Publication No. 2002/0004632, are correct, formal drawings. Applicants believe that the drawings are correct at this time and therefore respectfully request withdrawal of the objection to the drawings.

Claim Rejections

Claims 1, 3, 5-8, 9, and 14-16 stand rejected under 35 U.S.C § 102(e) as being anticipated by Thames *et al*, U.S. Patent Application Publication No. 2004/0199516 (hereafter 'Thames'). As will be shown below, Thames does not teach each and every claim element of claims 1, 3, 5-8, 9, and 14-16. Claims 1, 3, 5-8, 9, and 14-16 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1, 3, 5-8, 9, and 14-16.

Claims 2, 4, and 10-13 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Thames in view of Graham *et al*, U.S. Patent Application Publication No. 2002/0054013 (hereafter 'Graham'). As will be shown below, Thames or Graham, either alone or in combination, does not establish a prima facie case of obviousness for claims 2, 4, and 10-13 as claimed in the present application. Claims 2, 4, and 10-13 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 2, 4, and 10-13.

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Claim Rejections – 35 U.S.C. §102

Claims 1, 3, 5-8, 9, and 14-16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Thames *et al.* (U.S. Patent Application Publication No. 2004/0199516). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). As explained in more detail below, Thames does not disclose each and every element of claims 1, 3, 5-8, 9, and 14-16, and Thames therefore cannot be said to anticipate the claims of the present application within the meaning of 35 U.S.C. § 102. Because Thames cannot be said to anticipate the claims of the present application, the rejection should be withdrawn and the claims should be allowed.

Independent claim 1 recites “[a] computer program product . . . said computer program product comprising program instructions for performing the steps of: displaying an object on the display screen; displaying a tooltip on the display screen in response to the positioning of the cursor image over the object, *continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip.*” In rejecting claims 1, 3, 5-8, 9, and 14-16 as anticipated by Thames, the Office Action states that Thames at Figure 41A, page 42, paragraph 0652, discloses “displaying a tool tip on the display screen in response to the positioning of the cursor image over the object (Figure 41A, the tool tip (4101) is displayed when the cursor (1601) places over the left brace, page 42, 0652); [and] continuing to display the tool tip in response to the movement of the cursor from the object to the tool tip (Figure 41B, the tool tip (4101) is still displayed when the cursor (1601) places over the tool tip (0652)).”

Applicants respectfully note in response, however, that what Thames at Figure 41A, page 42, paragraph 0652, in fact discloses is displaying a tool tip in response to the positioning of the cursor image over the object, and *continuing to display the tooltip in response to the pressing of a predefined key.* “Pressing a predefined key (e.g., control key 4110 as

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illustrated in FIG. 41B) allows cursor 1601 to be moved into the tooltip to activate link 4102 resulting in appearance of a popup help window 4120, as illustrated in FIG. 41C.” Thames, page 42, paragraph 0652. Pressing a predefined key to activate a popup help window as described in Thames does not disclose “continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip” as claimed in the present application.

Claim Rejections – 35 U.S.C. § 103

Claims 2, 4, and 10-13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Thames in view of Graham. Applicants respectfully traverse each rejection. To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* § 2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 U.S.P.Q. 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants’ claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974).

Claims 2, 4, and 10-13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Thames in view of Graham. The proposed combination of Thames and Graham cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

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**The Proposed Combination of Thames and Graham
Does Not Teach all of Applicants' Claim Limitations**

The Office Action states that Thames at Figures 41A and 41B, and at page 42, paragraph 0652, discloses:

displaying a tool tip on the display screen in response to the positioning of the cursor image over the object (Figure 41A, the tool tip (4101) is displayed when the cursor (1601) places over the left brace, page 42, 0652); continuing to display the tool tip in response to the movement of the cursor from the object to the tool tip (Figure 41B, the tool tip (4101) is still displayed when the cursor (1601) places over the tool tip (0652)).

That is, the Office Action takes the position that Thames discloses elements of claim 1 of the present application. Elements of claim 1 are pertinent to this discussion of claim 2 because dependent claim 2 includes all the elements of claim 1. Applicants respectfully note in response, however, as discussed above with reference to the § 102 rejection, that what Thames at Figures 41A and 41B, and at page 42, paragraph 0652, in fact discloses is displaying a tool tip in response to the positioning of the cursor image over the object, and *continuing to display the tooltip in response to the pressing of a predefined key.*

"Pressing a predefined key (e.g., control key 4110 as illustrated in FIG. 41B) allows cursor 1601 to be moved into the tooltip to activate link 4102 resulting in appearance of a popup help window 4120, as illustrated in FIG. 41C." Thames, page 42, paragraph 0652. Pressing a predefined key to activate a popup help window as described at this point in Thames does not disclose "continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip" according to the claims of the present application.

Further with reference to claim 2: The Office Action states that Thames, at Figure 41A, discloses "the tool tip having an overlapping portion that overlaps the object on the

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display screen ..." as claimed in the present application. Applicants respectfully note in response, however, that Thames at Figure 41A and at page 42, paragraph 0652, in fact discloses a tooltip which does not overlap the object on the display screen—"the left brace in line 8"—a disclosure that has nothing whatsoever to do with a tool tip having an overlapping portion that overlaps the object on the display screen according to the claims of the present application.

Further with reference to claim 2: The Office Action admits at page 4:

Thames et al. fail to teach the step of continuing to display the tool tip is in response to the movement of the cursor from the object to the overlapping portion of the tool tip, followed by the movement of the cursor from the overlapping portion to the non-overlapping portion of the tool tip

The Office Action states on page 4 that it is suggested, apparently by Graham, that:

the mouse cursor points to the tool tip for a sufficient amount of time and a delay between when the mouse cursor is initially positioned to a point at the tool control on the tool bar and when the tool tip is displayed. The delay is sufficiently long to allow the user to move the mouse cursor if he does not want to receive a tool tip.

The Office Action takes official notice that the sufficient delay of Graham discloses:

continuing to display the tooltip [in] response to the movement of the cursor from the object to the overlapping portion of the tooltip, followed by the movement of the cursor from the overlapping portion to the non-overlapping portion of the tooltip.

That is, the Office Action admits that Thames does not disclose this element of claim 2, and then attempts official notice that Graham does disclose it. Applicants respectfully note in response, however, that Graham in fact discloses at a number points within

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Graham a sufficient delay *before initially* displaying the tool tip – which most definitely is not a disclosure of *continuing* to display the tooltip in response to the movement of the cursor from the object to the overlapping portion of the tooltip, followed by the movement of the cursor from the overlapping portion to the non-overlapping portion of the tooltip, as claimed in the present application.

No Suggestion or Motivation to Modify Thames

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation to modify Thames by combination with Graham. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to modify must come from the teachings of the references themselves, and the Examiner must explicitly point to the teaching within the references that suggests the proposed modification. Absent such a showing, the Examiner has impermissibly used “hindsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action states no rationale for motivation to combine Thames and Graham, other than a brief assertion at page 4:

It would have been obvious to one of skill in the art, at the time the invention was made, to combine the well known implementation of the continuation to display the tool tip with Thames et al. Motivation of the combining would have been to give user extra time to obtain additional information from the tool tip.

This assertion fails to explicitly point to the teaching within Thames and Graham suggesting the proposed combination. Therefore, the Examiner has used impermissible hindsight occasioned by Applicants’ own teaching to reject the claims.

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In addition, however, applicants respectfully submit that there never could be any suggestion to combine Thames with Graham. Thames in pertinent part is concerned with continuing display of a tooltip long enough to give a user an opportunity to invoke a link within the tooltip. Thames, page 42, paragraph [0652]. Graham discloses at several points *not* displaying a tooltip until after a pointer has remained on an icon for some period of time. Graham, however, is *completely unconcerned* with continuing display of a tooltip after a cursor leaves the icon associated with the tooltip. In this circumstance, neither reference can ever be expected to provide a motivation to combine the references. For the same reason, nothing in these references could ever suggest the combination to a person of skill in the art.

Thames Teaches Away From The Claims Of The Present Application

Thames actually teaches away from continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip as claimed in the present application. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). The present application claims "continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip." Thames, in contrast, teaches continuing to display the tooltip in response to pressing a predefined key—thereby teaching directly away from continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip as claimed in the present application. Because Thames teaches away from continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip as claimed in the present application, the proposed modification of Thames by Graham cannot support a prima facie case of obviousness.

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**No Reasonable Expectation of Success in the
Proposed Combination of Thames and Graham**

To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success in the proposed modification of Thames. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 U.S.P.Q. 375, 379 (Fed. Cir. 1986). There can be no reasonable expectation of success in a proposed modification if the proposed modification changes the principle of operation of refl. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959).

The principal of operation for continuing to display a tooltip according to Graham is: Nothing. There is no such principal in Graham. Graham makes no mention whatsoever of any continuation of display. Graham at several points does mention *not* displaying a tooltip for some period of time after a mouseover on an icon, but Graham makes no mention whatsoever of continuing to display a tooltip as a result of any manipulations of the interface, including operations of function keys and pointer motions. Graham's principle of operation for continuing to display a tooltip is that Graham has no principle of operation to continue to display a tooltip. The principle of operation in Thames, however, for continuing to display a tooltip is to continue to display the tooltip while a function key is activated. Thames, page 42, paragraph [0652]. Implementing the principle of operation of Thames, continuing to display a tooltip while a function key is depressed, completely destroys the principle of operation of Graham regarding continued display of a tooltip – which is doing nothing. There can therefore be no reasonable expectation of success in the proposed combination Thames and Graham.

The inoperability of the combination is even clearer when viewed from the point of view of Thames. Thames has a principle of operation for continuing to display a tooltip: continue to display the tooltip while a function key is pressed. Adding the function of Graham, doing nothing to continue display of a tooltip, definitely destroys the principle

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of operation of Thames. For all these reasons, there can be no reasonable expectation of success in the proposed combination of Thames and Graham.

Official Notice

The Office Action states on page 4 that “[o]fficial notice is taken that implementation of continuing to display the tool tip is in response to the movement of the cursor from the object to the overlapping portion of the tool tip, followed by the movement of the cursor from the object to the overlapping portion to the non-overlapping portion of the tool tip.” Applicants respectfully propose in response, however, that official notice of “continuing to display the tool tip is in response to the movement of the cursor from the object to the overlapping portion of the tool tip, followed by the movement of the cursor from the object to the overlapping portion to the non-overlapping portion of the tool tip” is not available to the Examiner in this case.

The Applicants respectfully note that “official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” *Manual of Patent Examining Procedure* § 2143.03. Official notice, however, may not be substituted for facts which cannot be instantly and unquestionably demonstrated. As indicated in *In re Lee*, 277 F.3d at 1343-44, 61 U.S.P.Q. at 1433-34, the examiner’s finding of whether there is a teaching, motivation or suggestion to combine the teachings of the applied reference must not be resolved based on “subjective belief and unknown authority,” but must be “based on objective evidence of record.” The court in *Lee* requires evidence for the determination of unpatentability by clarifying that “common knowledge and common sense,” as mentioned in *In re Bozek*, 416 F.2d 1385, 1390, 163 U.S.P.Q. 545, 549 (C.C.P.A. 1969), may only be applied to analysis of the evidence, rather than be a substitute for evidence. *Lee*, 277 F.3d 1345, 61 U.S.P.Q.2D at 1435.

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In this case, Applicants note with respect that the Examiner has made a mere naked assertion that implementation of the continuation to display the tool tip is well-known with absolutely no "objective evidence of record" and no expression of any reason why one having ordinary skill in the pertinent art would have been led to modify the prior art to arrive at the claimed invention. As mentioned, official notice may not be substituted for facts which cannot be instantly and unquestionably demonstrated. For these reasons, the Examiner in this case cannot have recourse to official notice of facts well known in the prior art and this rejection therefore fails to establish a prima facie case of obviousness.

Relations Among Claims

Independent claim 9 claims system aspects of the method claimed in claim 1. Claim 9 therefore is patentable for the same reasons that claim 1 is patentable as described above. Dependent claims 2-8, and 10-16 depend respectively from independent claims 1 and 9. The dependent claims include each and every limitation of the independent claims from which they depend. Because Thames does not disclose or enable each and every element of the independent claims, Thames does not disclose or enable each and every element of the dependent claims of the present application. As such, claims 2-8 and 10-16 are also patentable and should be allowed.

Conclusion

Claims 1-8 and 9-16 stand under 35 U.S.C § 102(e) and § 103(a) as being anticipated by Thames and Graham, alone or in combination. Neither Thames nor Graham, alone or in combination, discloses each and every element of Applicants' claims. Thames and Graham therefore do not anticipate Applicants' claims. Claims 1-8 and 9-16 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-8 and 9-16.

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The Commissioner is hereby authorized to charge or credit Deposit Account No. 50-0563 for any fees required or overpaid.

Respectfully submitted,

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By: 

John Biggers
Reg. No. 44,537
Biggers & Ohanian, LLP
P.O. Box 1469
Austin, Texas 78767-1469
Tel. (512) 472-9881
Fax (512) 472-9887
ATTORNEY FOR APPLICANTS